REMARKS/ARGUMENTS

Claims 1, 3-8, 10-11, 13-16, 18-19 and 21-22 are pending in the present application. Claims 2, 9, 12, 17 and 20 were canceled; Claims 1, 3, 8, 11 and 16 were amended; and Claims 21-22 were added. Reconsideration of the claims is respectfully requested.

In a phone interview on July 26, 2007, the Examiner and Applicants'attorney discussed an Office Action in the above application that was mailed May 4, 2007. Applicants through their attorney express appreciation to the Examiner for granting this interview, and for the very helpful comments and guidance that the Examiner provided.

I. 35 U.S.C. § 102, Anticipation

The Examiner has rejected Claims 1-5, 8 and 11-20 under 35 U.S.C. § 102 as being anticipated by U.S. Patent Appl. Pub. No. 2005/0004986, to Aoki (hereinafter "Aoki"). The Examiner has also rejected Claim 1, 5-7 and 9-10 under 35 U.S.C. § 102 as being anticipated by U.S. Patent Appl. Pub. No. 2004/0257346, to Ong (hereinafter "Ong"). These rejections are respectfully traversed.

II. Teachings of Applicants

In making their invention, Applicants were concerned with reducing the time and effort needed to send a document, or selected portion thereof, to another location or application. Applicants recognized that this goal could be achieved by providing a method and apparatus wherein a single user input can initiate the entire procedure of sending specified content from a first application to a second application. Thus, no further user input is needed to complete the transfer of content. Moreover, a user is able to select the second application from a plurality of different applications, over an extensive range of application types. For example, the second application may be selected to be an email program or an instant messaging program for transmission over a network. Alternatively, the second application may be a file or word processing program located in the same data processing system as the first application. The single user input used to initiate the procedure merely needs to indicate the particular application that the user has selected, from the plurality of different applications, to serve as the second application. As a result, the effort required by a user to send content from one application to another is substantially reduced.

These teachings are set forth in Applicants' specification, such as at page 3, lines 3-14, and page 9, lines 23-page 10, line 13, as follows.

> The present invention provides a method, apparatus, and computer instructions for sending content from a first application to a second application. In response to user input indicating a selection of content for transfer to the second application, the selection

of the content is copied to form copied content. The copied content is then automatically sent to the second application without requiring additional user manipulation of the copy content. Additionally, the destination may be another user. In this case, the second application is employed to automatically transfer the copied content to that second user. **[page 3, lines 3-14]**

Thereafter, the user through some selected user input, such as a right click on a mouse or other pointing device may select to send data 304 to another location. This location may be, for example, application 308 or even a file, such as file 310 within the data processing system.

Application 308 may take various forms, such as an email program, another word processing program, or an instant messaging program. In the event that application 308 is to be used as a transport mechanism to send the data to a remote location, the mechanism of the present invention may initiate the execution of application 308. Data 304 is sent to application 308 through an interface in application 308. This interface is typically an existing interface that allows for a transfer of content to the application. Alternatively, a set of scripts may be used to manipulate application 308.
In these examples, the reception of the user input selecting the destination for the data and the initiation of application 308 is handled by data transfer process 312. **[page 9, line 23-page 10, line 13]**

III. Rejection of Claim 1

In the Office Action, the Examiner stated the following in rejecting Claim 1:

2. Claims 1-5, 8 and 11-20 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Aoki et al, U.S. pat. Appl. Pub. No. 2005/0004986.
Per claims 1-4, Aoki discloses a system and method for sending content from a first application to a second application, comprising:
a) responsive to detecting a user input indicating a selection of the content (e.g., excel worksheet) for transfer to the second application, copying the selection of the content to from copied content in a clipboard (see page 4, par. 49-50);
b) initiating a communication program (e.g., IM program) (par. 51); and
c) automatically sending the copied content from the clipboard to the second application, i.e., when the remote user requests the copied content (see page 5, par. 62). **(Office Action dated May 4, 2007, pp. 2-3)**

Per claims 1 and 9-10, Ong discloses a system and method for sending content from a first application to a second application comprising:
a) responsive to detecting a user input indicating a selection of the content, capturing/copying the selection of the content to form captured/copied content (see page 4, par. 56);
b) presenting a graphical user interface to provide user's selection of a transfer type (see par. 57-58);

c) automatically sending the copied content to the second application (see page 8, par. 144). **(Office Action dated May 4, 2007, pp. 2-3)**

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed Cir. 1983). Moreover, it is a fundamental principle of patent law that prior art must be considered in its entirety. **MPEP 2141.02**.

IV. Independent Claims 1, 11 and 16 Distinguish over the Cited References

In the Office Action, Ong was not cited in rejecting Claim 2, which depends from independent Claim 1. Accordingly, the recitation of Claim 2 distinguishes over Ong. Moreover, Aoki was not cited in rejecting Claim 9, which also depends from Claim 1. Thus, Claim 9 distinguishes over Aoki. In view of this, Claim 1 has been amended to recite the limitations of Claims 2 and 9, which have respectively been canceled. Therefore, Claim 1 now distinguishes over both Aoki and Ong.

Independent Claims 11 and 16 have both likewise been amended to recite the limitations of Claims 2 and 9. Accordingly, these claims also now distinguish over the Aoki and Ong references.

V. Claim 21 Distinguishes over the Cited References

Applicants respectfully submit that both cited references fail to teach every element of the claimed invention, arranged as they are in new Claim 21. For example, neither Aoki nor Ong teaches, in the overall combination of Claim 21, the following Claim 21 features:

> (1) Responsive to detecting a single user input indicating selection by the user of a particular application of the plurality to be the second application, copying the content to form copied content, and, without further user input, initiating the particular selected application to be the second application, and also sending the copied content to the second application (hereinafter "Feature (1)").

(2) Providing a plurality of different applications, wherein each of the provided applications is available for selection by a user as the second application that is to receive the content from the first application (hereinafter "Feature (2)")

Principal teachings of Aoki are set forth at paragraphs [0029] and [0049]-[0056], and at Figure 2A. These are as follows:

> **[0029]** What is desired is a mechanism that allows copying a fragment of a document from a sending computer and populating a remote receiving computer's clipboard via an Internet based messaging system, so that the receiving user at the remote receiving computer can paste the transferred fragment into another document using a standard paste command.
>
> **[0049] FIG. 2A** is a flow diagram illustrating an exemplary process for transferring a fragment of document from a sending computer's clipboard to a receiving computer's clipboard via an instant messaging system. The process includes the following steps:
> **[0050]** Step **201**: The sending user copies a selected fragment of document, resulting in the sender's clipboard being populated;
> **[0051]** Step **202**: The sending user clicks the message entry box of the messaging system's client application;
> **[0052]** Step **203**: The sending user applies a standard Paste command (e.g. pressing "Ctrl" key and "V" key at the same time or clicking "Paste" from the "Edit" menu);
> **[0053]** Step **204**: The sending user clicks a Send button, resulting in such an automatically generated system message being immediately displayed in the communication screen as: <System message: Click HERE to place this Microsoft Excel fragment into your clipboard>.
> **[0054]** Step **205**: The receiving user clicks a link included in the system message, resulting in the receiver's clipboard being populated;
> **[0055]** Step **206**: The receiving user selects a place where the copied fragment is to be pasted; and
> **[0056]** Step **207**: The receiving user applies a standard Paste command, e.g. pressing "Ctrl" key and "V" key at the same time or clicking "Paste" from the

"Edit" menu, resulting the copied fragment into the selected place by the receiving user.

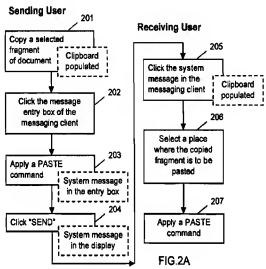

FIG.2A

Feature (1) of Applicants' Claim 21 teaches that in response to detecting a user input indicating selection by the user of a particular application, which is to be the second application, copied content is formed. Then, without further user input, the particular application is initiated to be the second application, and the copied content is sent thereto. Thus, in response to the single user input recited by Feature (1), the copied content is automatically sent to the second application. As a result, no further user input or manipulation is needed, in order to carry out the entire content sending task. Accordingly, Feature (1) of Claim 21 achieves an essential objective of Applicants, as discussed above and disclosed in the specification at page 3, lines 8-11. That is, the "copied content is then automatically sent to the second application without requiring additional user manipulation of the copied content".

At paragraph [0029], Aoki states that the objective thereof is to allow a document fragment to be copied from a sending computer, and to be delivered to the clipboard of a remote receiving computer, via an Internet based messaging system. This is to be done so that the receiving user can paste the fragment into another document. Accordingly, the purpose of Aoki is very different from the purpose of Applicants' claims.

Moreover, it is readily apparent that essential teachings of Aoki are fundamentally different from the teachings of Feature (1) of Claim 21. This difference is clearly emphasized at [0049] – [0056], as well as at Figure 2A of Aoki. Figure 2A is a flow diagram "illustrating an exemplary process for transferring a fragment of document from a sending computer's clipboard to a receiving computer's clipboard via an instant messaging system". Figure 2A discloses that in order to carry out such task, the sending user and the receiving user are both required to perform repeated inputs. For example, at step 201 the sending user

must copy a selected document fragment. At step 202, the sending user must click the message entry box of the messaging system's client application. At step 203, the sending user generates a Paste command, and at step 204 the sending user must click a Send button. Further inputs are required by the receiving user, at steps 205 -207.

It is very clear that the large number of inputs required to carry out the transfer procedure of Aoki are completely incompatible with the single user input specified by Feature (1) of Applicants' Claim 21. Accordingly, Aoki emphatically teaches away from this feature of Claim 21.

Feature (2) of Claim 21 is likewise considered to distinguish over Aoki. As repeatedly emphasized by Aoki, such as at paragraph [0029] and elsewhere, Aoki is concerned with transferring a fragment of a document from a sending computer to a receiving computer, via an Internet based messaging system. Thus, Aoki fails to disclose or suggest the Feature (2) recitation of providing a plurality of different applications, wherein each of the applications is available for selection by a user, as the second application that is to receive the content from the first application.

In regard to the Ong reference, the Examiner indicated that Ong did not show the subject matter recited by original Claim 2, as discussed above. Accordingly, Claim 21 recites the subject matter of original Claim 2, so that Claim 21 clearly distinguishes over Ong. In addition, Claim 21 distinguishes over Ong in reciting both Features (1) and (2) of Claim 21. Applicants consider that Ong neither shows nor suggests either of these features.

VI. Remaining Claims Distinguish over the Cited References

Claims 3-8 and 10, 13-15 and 18-19 depend from Claims 1, 11 and 16, respectively, and are each considered to patentably distinguish over the art for at least the same reasons given in support thereof.

Claim 22 depends from Claim 21, and is considered to patentably distinguish over the art for at least the same reasons given in support thereof. Claim 22 additionally distinguishes over the art in reciting the feature that the plurality of provided applications includes at least a word processing program located in the data processing system, and an e-mail program for transferring the content over a specified network. Neither of the cited references is considered to show this feature.

VII. Conclusion

It is respectfully urged that the subject application is patentable over Aoki and Ong, and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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